

DETAILED ACTION

Drawings

1. Figures 10-15 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

2. The specification appears to be a literal translation into English from a foreign document and is replete with grammatical and idiomatic errors. A substitute specification in proper idiomatic English and in compliance with 37 CFR 1.52(a) and (b) is required. The substitute specification filed must be accompanied by a statement that it contains no new matter.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors. In addition, where applicant acts as his or her

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own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). The term “joint seat” in claims 1 and 5 is used by the claim to refer to “a flat sheet”, while the accepted meaning is “a shaped structure into which a joint such as a ball joint sits.” The term is indefinite because the specification does not clearly redefine the term. The claims as currently recited are further indefinite for the following reasons:

- a. In Claim 1, “the outermost layer” and “said cold roll” lack antecedent basis.
- b. In Claim 1, “its flexibility and smoothness” lacks clear antecedent basis for the term “its”.
- c. In Claim 2, the phrase “the smoothness of said outermost layer is that the surface roughness Rz is less or equal to 20µm” is unclear.
- d. In Claims 3 and 7, “the composition”, “the rate of aramid fiber”, and “the rate of rubber” lacks antecedent basis.
- e. With respect to Claims 3, 5, and 7, the term “rate” usually refers to a particular parameter measured over time however it appears as if the Applicant is using the term to refer to a content or an amount. The claims also fail to provide a basis for the weight percentage.
- f. In Claim 5, “the fundamental composition”, “the rate of aramid fiber” and “the rate of NBR”, “the rate of phenol resin”, and “the remainder” lack clear antecedent basis.

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g. With respect to Claim 6, it has been held that the use of the term “type” extends the scope of the expression as to render it indefinite. See *Ex parte Copenhaver* 109 USPQ 118.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1, 5 and 6 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 14 of copending Application No. 10/520177. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the copending application fully encompass the instant claims wherein one of the layers of the copending application reads upon the instantly claimed gasket or alternatively two or more layers of the same composition would essentially be the same as a single monolayer have a combined thickness.

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This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1, 3, 5, and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Lindeman et al (USPN 4,330,442.) Lindeman et al teach an asbestos-free gasket forming composition comprising about 3 to about 60 parts by weight of phenolic fibers, per 100 parts of the total fiber and filler weights; about 5 to about 50 parts by weight of aramid fibers; about 10 to 80 parts by weight of an inorganic or cork filler; and about 10 to about 40 parts by weight add-on of a synthetic rubber binder, such as NBR, per every 100 parts of the total fiber and filler weight; as well as standard rubber latex curing agents (Abstract; Col. 2-3.) Lindeman et al also teach that the composition can be pressed and drum dried, and cured to produce a gasket material (Examples.)

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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10. Claims 2, 4, and 7-9 rejected under 35 U.S.C. 103(a) as being unpatentable over Lindeman et al. The teachings of Lindeman et al are discussed above. Though Lindeman et al do not specifically teach that the gasket comprises multiple layers with an outermost layer having a thickness and surface roughness as instantly claimed, it would have been obvious to one having ordinary skill in the art at the time of the invention to utilize routine experimentation to determine the optimum surface roughness, number of layers and layer thickness to provide the desired sealing properties between the two elements for which the gasket is desired.

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Saito et al (US 2003/0203220A1) teaches a gasket material including a steel plate and a cured film made from a mixture of unvulcanized NBR rubber and a phenol-modified xylene resin directly formed on one or both sides of the steel plate as a solution layer having a thickness of 20 to 150 microns.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monique R. Jackson whose telephone number is 571-272-1508. The examiner can normally be reached on Mondays-Thursdays, 10:00AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Monique R Jackson/
Primary Examiner, Art Unit 1794
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